

**Remarks.**

Reconsideration of the present application is respectfully requested. In this amendment Claims 1-41 are pending and stand rejected. Thus, Claims 1-41 are currently at issue. Reconsideration and allowance of the above-referenced application is respectfully requested. Applicant submits that no claims or new matter has been added. Further, amendments are not intended to narrow claim scope, but rather for clarification purposes only.

**Support for the Amendments**

**35 U.S.C § 101 REJECTION**

The Examiner has rejected Claims 1-3, 5-9, 11, 17-27 and 29-33 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, in that, Claim 1 recites in the preamble “a system for providing information to user” and the body of Claim 1 recites “means for generating...” for each limitation. The Examiner has indicated that Claim 1 is non-statutory because it is directed towards software per se, lacking storage on medium, which enables any underlying functionality to occur. The Examiner further states that it is not clear whether instructions are in executable form and therefore there is no practical application. The Examiner rejects the dependent claims, Claims 2-3, 5-9, 11, 17-27 and 29-33 because they are directed towards “software per se,” lacking storage on a medium, which enables any underlying functionality to occur.

In this response, Applicant has amended Claim 1 to provide the structure for the functionality of the system. Claim 1 was amended to include the system including computer executable modules embodied on a computer readable medium useful in association with a computer which includes a processor and a memory, the computer readable medium containing computer instructions configured to cause the computer to provide information to a user. Applicant believes that the corrections satisfy the Examiner’s concerns with respect to providing storage on a medium. See *Ex Parte Praveen Seshadri et al*, Appeal 2008-2854 (indicating “independent claims 1, 21, 32, and 37 recite ‘a component executing on a computer’ in the body of the claim. Thus, these claims require execution on a computer to ‘create’ other limitations recited in the claim. Therefore, we conclude that independent claims 1, 21, 32 and 37, and the claims which

depend from them, are not software per se"). *See also* MPEP § 2106.01 ("[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized). *Ex parte Bo Li*, Appeal 2008-1213 (BPAI 2008). Furthermore, the recited language has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). As such, Applicant respectfully submits that Claims 2,3, 5-9, 11, 17-27 and 29-33 depend from Claim 1 which includes statutory subject matter and are allowable.

### **35 U.S.C § 112 REJECTION**

The Examiner has rejected Claims 1-41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner indicates "[i]n particular, claim 1 recites in the preamble 'a system for providing information to a user...' the body of the claim does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant's claimed limitations consist of modules (software according to the specification) that do not describe the structure of the device. Appropriate correction is required."

Applicant contends that the system for providing information to a user provides information to a user which includes the following structural components of the claimed system: a first database; means for generating a first predetermined content for storage in said first database; a second database; means for generating a second predetermined content for storage in said second database; server means; means for interconnecting said first and second databases to said server means; a plurality of transceivers; means providing access by each of said transceivers to said server means; and selector means on each said transceiver for selectively accessing said first and second content. Applicant contends that these elements form the structure of the system and aid in providing information to a user.

In this response, Applicant has amended and further provided the structure for the functionality of the system to occur, as Claim 1 was amended to include the system including computer executable modules embodied on a computer readable medium useful in association with a computer which includes a

processor and a memory, the computer readable medium containing computer instructions configured to cause the computer to provide information to a user.

Applicant believes that the corrections satisfy the Examiner's concerns with respect to providing storage on a medium. *See MPEP § 2106.01*("[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory"). See also *Ex parte Bo Li*, Appeal 2008-1213 (BPAI 2008). This combination has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Circ. 1994). As such, the applicant has positively recited structural elements of the system, rendering the Claims as definite and distinctly claiming the subject matter the Applicant regards as the invention. *Ex Parte Godwin*, Appeal 2008-0130 (BPAI 2008).

The Applicant respectfully submits that because Claim 1 is definite and particularly points out and distinctly claims Applicant's invention, dependent claims 4, 10, 12 -16, 28 and 34-41 should be reconsidered because they contain limitations that indicate structure or hardware of the system or device and depend from Claim 1. Furthermore, Applicant contends that dependent claims 2-3, 5-9, 11, 17-27 and 29-33 do contain structure or hardware of the system. As amended, Claim 1 includes structural components of a system including hardware and software functionality. Claims 2-3, 5-9, 11, 17-27 each include limitations of the elements in Claim 1 and narrow the invention in the type, location or means by which information is collected within the system, the network configuration of the system or the connectivity of the system, and each lends itself to further structural limitations on the system. These dependent claims should be allowed.

### **35 U.S.C. § 102 (e) REJECTION**

The Examiner has indicated that Claims 1-24 and 26-41 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,587,835, hereinafter "reference." The Examiner has indicated that with respect to Claim 1, the references teaches a system for providing information to a user comprising: a first database; means for generating a first predetermined content for storage in said first database (see at least col.1 line 20-40); a second database; means for generating a second predetermined content for storage in said second database (see at least col.2 line 65-col.3 line 6); server means; means

for interconnecting said first and second databases to said server means (see at least col.22 line 65-col.1.23 line 6); a plurality of transceivers; means providing access by each of said transceivers to said server means; and selector means on each said transceiver for selectively accessing said first and second content (see at least abstract, col.1.9 -col.1.10, fig.1 and 5).

The Applicant notes the Examiners rejection. Applicant has attached a declaration under 37 C.F.R. 1.131, and herein provides that Applicant is the inventor of the subject matter of the rejected claim and submits the appropriate declaration to establish conception of the invention of the subject matter of the rejected claim prior to the effective date of the reference supplied by the Examiner, and a subsequent reduction to practice upon filing United States Provisional Patent Application No. 60/432,808. Applicant further provides evidence of due diligence from at least as early as the provided conception date to at least one reduction to practice date, herein the filing date of the United States Provisional Application No. 60/432,808, as a constructive reduction to practice date. Applicant respectfully requests reconsideration in light of the attached declaration.

### **35 U.S.C § 103(a) REJECTION**

The Examiner has rejected Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over the provided reference. The Examiner notes that as per claim 25, the reference does not expressly teach providing information to send user based on said user's past history within said local environment. However, the examiner takes Official Notice that recommending information to the user based on prior history or shopping history is old and well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the reference to include the teaching of Official Notice, in order to assist the consumer when shopping by recommending items that might be of interest to the consumer based on prior purchases. Applicant wholeheartedly disagrees.

Applicant has effectively removed the reference supplied by the Examiner under the section 35 U.S.C. § 102(e) rejection set forth above by providing a 37 C.F.R. § 1.131 declaration. As such, the elements the Examiner cites for the reference cannot be supplied in order to provide a proper rejection under 35 U.S.C. § 103.MPEP §2143.03 ("[t]o establish prima facie obviousness of a claimed invention, all

the claim limitations must be taught or suggested by the prior art"). *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant further contends that the subject matter of Claim 25 is *not* well-known or common knowledge in the art, and is much different than the determination of the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), wherein the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it").

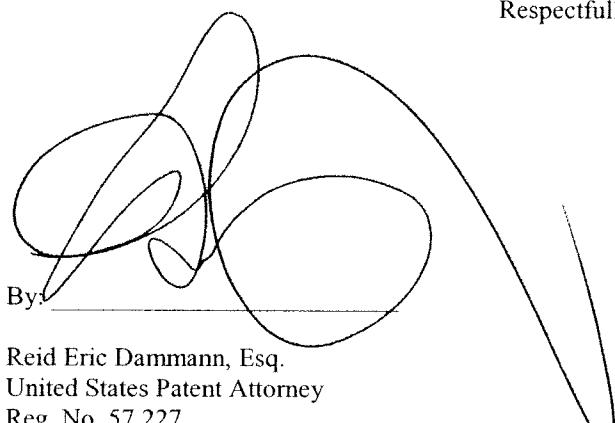
In fact, recommending information to the user based on prior history, wherein that information is collected from a local environment over a network and transmitted to a transceiver, is not well-known and cannot be judicially noticed. At the time of filing, this technology cannot be said to be said to equate to "adjusting the intensity of a flame" or when recording over old material on a tape, erases that previously recorded material. This is evidenced by a search of the United States Patent and Trademark Office patent and patent publications databases, as well a search on Google, in that, use of the relevant terminology leads to Applicant's patent application publication.

Regardless, because Applicant has effectively removed the cited prior art of record, and that in order to establish *prima facie* obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. Thus a rejection under 35 U.S.C. § 103(a) is inappropriate under the circumstances. *See Attached 37 C.F.R. 1.131. See also MPEP §2143.03. In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

### CONCLUSION

Applicant, accordingly, respectfully requests withdrawal of the rejections of Claims 1-41 and are therefore in a condition for allowance. If the Examiner's next action is other than allowance of Claims 1-41, or the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to contact Applicant at (818) 554-8007 or the below, who is not of record, but acts in a representative capacity under the provisions of 37 C.F.R. § 1.34.

Respectfully submitted,

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Dated:

4/8/2009

Dated:

(310) 266-0675

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on \_\_\_\_\_

4/8/2009